



41

1653-

PTO/SB/21 (03-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/909,077
Filing Date	07/19/2001
First Named Inventor	Ashok Arasappan
Art Unit	1653
Examiner Name	David Lukton
Attorney Docket Number	IN01156

Total Number of Pages in This Submission 14

RECEIVED  
AUG 07 2003  
TECH CENTER 1600/2900

## ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☒ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation
- ☐ Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_

- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):  
Certificate of Mailing (1pg.) ; Post Card;  
\* Please see Remarks section...

### Remarks

- Also enclosed:
- (1) Marked-Up Amendment - 2pgs.
  - (2) Response to Restriction Requirement and Sequence Listing - 3pgs.
  - (3) Sequence Listing - 4pgs.
  - (4) Sequence Listing on Floppy - 1 diskette

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Palaiyur S. Kalyanaraman , Reg. No. 34,634
Signature	
Date	07/31/2003

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: \_\_\_\_\_

Typed or printed			
Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Attorney Docket No.: IN01156

Application No.: 09/909,077

Filing Date: 07/19/2001

Inventor: Arasappan et al.

PTO/SB92 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U. S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.



### Certificate of Mailing under 37 CFR 1.8

RECEIVED  
AUG 07 2003  
TECH CENTER 1600/2900

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

**Commissioner for Patents**

P.O. Box 1450

Alexandria, VA 22313-1450

Mailstop: Non Fee Amendment

on 07/31/2003  
Date

Signature

Palaiyur S. Kalyanaraman, Reg. No. 34,634

Typed or printed name of person of signing Certificate

**Note:** Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

**Documents submitted:**

Response Transmittal - 1pg. ; Amendment - 3pgs

Marked-Up Amendment - 2pgs.

Response to Restriction Requirement and Sequence Listing - 3pgs.

Sequence Listing - 4pgs.

Sequence Listing on Floppy - 1 diskette ; Post Card ; Certificate of Mailing

**Burden Hour Statement:** This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U. S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



PATENT: IN01156

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

A. Arasappan *et al.*

Serial No.: 09/909,077

Filed: July 19, 2001

)  
)  
) Examiner: D. Lukton  
)  
) Group Art Unit: 1653  
)  
)  
) Atty. Docket No.: IN01156

RECEIVED  
AUG 07 2003  
TECH CENTER 1600/2900

For: **Novel Imidazolidinones as NS3-Serine Protease Inhibitors of Hepatitis C Virus**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT AND SEQUENCE LISTING**

Sir:

This communication is an Amendment and a response to the restriction requirement issued by the Examiner on July 15, 2003, in the above-identified patent application. Included in this communication are: a response to restriction requirement, an amendment to satisfy sequence listing, a sequence listing and a floppy disk containing said sequence listing.

Claims 1-47 are currently pending in the application. The Examiner restricted the claims into four groups (as subgenera) and twelve inventions: Group 1 (R<sup>1</sup> limited to COR<sup>5</sup>, and R<sup>5</sup> is limited to N(R<sup>9</sup>)(R<sup>10</sup>)); Group 2 (R<sup>1</sup> being moieties other than in Group 1); Group 3 (X limited to carbonyl or thiocarbonyl); and Group 4 (X limited to C[(R)(R')]<sub>p</sub>). The claims were divided up into 12 different ways to match the four groups.

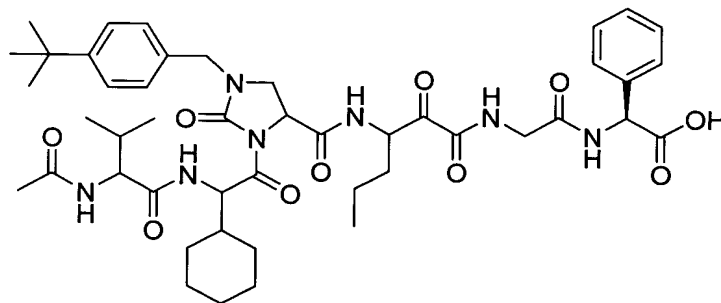
Applicants are puzzled by these restrictions. Applicants believe that all claims 1-47 form part of one and the same invention. Applicants believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-47 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submits that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicants believe that the Examiner has not established a clear reason to establish the existence of any of the above 4 groups and 12 patentably distinct inventions. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

Furthermore, in order to comply with the Examiner's requirement, Applicants are electing, with traverse, the invention cited as Invention No. 3 by the Examiner as limited to groups 2 and 3. Applicants believe that this should also appropriately include the inventions classified as Invention Nos. 6, 7, 10 and 11 by the Examiner. Additionally, in order to comply with the requirement that a species be elected for examination purposes, Applicant is electing the following compound:

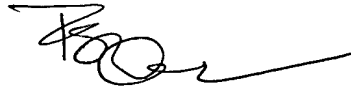


The above-shown compound occurs in Table 9 on page 67 of the application, as well as in Claim 43 (Compound No. 57).

Also enclosed herewith are an Amendment to satisfy the sequence listing, a Marked-up amendment and a sequence listing (paper copy and CRF on diskette).

If the Examiner has questions, the Examiner is invited to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Dr. Palaiyur S. Kalyanaraman', with a long horizontal stroke extending to the right.

Dr. Palaiyur S. Kalyanaraman  
Registration No. 34,634  
Attorney for Applicants  
Tel: 908-298-5068  
Fax: 908-298-5388